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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,286	01/24/2002	William B. Kerfoot	10578-014001	9549

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BOSTON, MA 02110

EXAMINER

SMITH, MATTHEW J

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/056,286

Applicant(s)

KERFOOT, WILLIAM B.

Examin r

Matthew J. Smith

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 18-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2-1-83 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 drawn to dredger, classified in class 37, subclass 323.
- II. Claims 18-28, drawn to a method of strata relocation, classified in class 405, subclass 129.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I., a dredger, and II., a method of strata relocation, are related as subcombination and combination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because any type of dredger can relocate strata. The subcombination has separate utility such as mineral recovery.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Jeffrey Hsi on 7 March 2003 a provisional election was made with traverse to prosecute the invention of Group I., claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rotatable outlet, submersible pump, and strata relocation must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are also objected to under 37 CFR 1.84(h) because Figure 2A show(s) two views of the device. Each view (top, side) must be labeled separately and described separately in the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 4, 12-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brouwer et al. (5979088) in view of Robertson et al. (5155928). Brouwer et al. disclose a casing 12, water inlet piping 61, slurry outlet piping 10, pipe outlet 60, the casing suitably supported (col. 1, lines 19-22), screen or opening with grating 25, and submersible slurry pump 4.

The reference does not disclose a rotatable, side angled nozzle, a water pump, or water source. Robertson et al. show a rotatable, side-angled nozzle 26 and a water pump (note col. 2, line 13).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the Robertson et al. nozzle and pump in the Brouwer et al. device for better operation in both the horizontal and non-horizontal positions (col.1, lines 17-20). Further, the source of the water, either ambient or from a supply on the dredger, would also have been obvious since any liquid the system can pump is acceptable.

Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brouwer et al in view of Robertson et al. as applied to claim1 above, and further in view of Grable (4497519). The combination shows a dredger with a modified excavating nozzle but not separate casings for the excavating water and slurry. Grable presents casings for excavating 15 and slurry 21.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use separate casings for the excavating and removal, as presented by Grable, in order to allow an efficient operation (col. 1, lines 56-64). Also, to place the casings at opposite ends of the vessel would have been obvious since the exact positions are not critical, as long as the excavating and removal operation can be carried out. Further, using both pipes to excavate and remove would have been obvious since one of ordinary skill would recognize the structure is capable of doing both.

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Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brouwer et al in view of Robertson et al. as applied to claim 12 above, and further in view of Ewig (1750095). The combination shows a dredger with a modified excavating nozzle but not a sand sprinkler or a conduit for strata relocation. Ewig reveals sand sprinkler d and relocating pipe h.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to store the slurry and relocate the material, as revealed by Ewig, so that the material can be unloaded (page 1, lines 4-9).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dean, Jr. (5775836) discloses relocating strata.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 703-305-5135. The examiner can normally be reached on M-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.

MJS *MJS*
March 10, 2003


DAVID BAGNELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600